

REMARKS

The Examiner is thanked for the thorough examination of the present application. The Office Action, however, has continued to reject all claims 1-8. In particular, claims 1-8 are rejected under 35 U.S.C. 103(a) as allegedly unpatentable over May (US 6,211,613) in view of the Van Order (US 6,247,820). Applicants respectfully traverse this rejection.

Claims 1-8 are pending in this application. Each of the originally filed claims was rejected in view of prior art. In particular, claims 1-8 are rejected under 35 U.S.C. 103(a) as allegedly unpatentable over May (US 6,211,613) in view of the Van Order (US 6,247,820). Applicants respectfully request reconsideration and withdrawal of these rejections.

Rejection to claim 1

As noted above, the Office Action rejected independent claim 1 under 35 U.S.C. 103(a) as allegedly unpatentable over May in view of the Van Order. Independent claim 1 recites:

1. An organic electroluminescent display, comprising:
an organic electroluminescent display (OLED) panel;
a reflective sheet; and
a brightness regulating film for light transmission between the organic electroluminescent display panel and the reflective sheet.

(Emphasis added.)

As illustrated in Fig. 1 and 2, and related description thereof in the May patent, May does not teach formation of a brightness regulating film formed between the OLED panel and the reflective sheet but teaches formation of a circular polarizer (i.e. reference numeral 14) in front of a glass substrate 12 (see Fig. 1) and formation of an antireflection coating (i.e. reference numeral 16) placed on the viewing surface of the glass substrate 12 (See Fig. 2), both for improving

contrast of an electroluminescent display.

As is further illustrated in Figs. 1 and 2, and described in the related description thereof in Van Order, **Van Order does not teach formation of a brightness regulating film formed between the OLED panel and the reflective sheet** but teaches an electro-optic medium 15 positioned between and attached to the first sides 17a and 19a of a front conductive layer 17 and a rear conductive layer 19, respectively. Instead, Van Order merely discloses an electro-optical mirror display system, but not an OLED display system. In addition, the electro-optic medium of Van Order reduces the amount of glare reflected to the driver by a surface 26 under nighttime conditions.

Further, as each of the above cited references is complete and function in itself, there would be no reason to use as part from or add or substitute parts to any reference. That is, the cited references are individually complete. In addition, the brightness regulating film of the present application has a unique advantage of simultaneously adjusting light intensities from the OLED panel and environmental lights, and this advantage is not taught or suggested in any of the cited references.

For at least these reasons, independent claim 1 patently defines over the cited art of record. Thus, it is respectfully submitted that the claim 1 is allowable over May in view of Van Order, since May and Van Order are both legally deficient for the purpose of rendering claim 1 obvious. Therefore, Applicant respectfully asserts that the claim 1 is in condition for allowance.

As a separate and independent basis for the patentability of claim 1, Applicants respectfully submit that the Office Action has failed to cite a proper motivation or suggestion for combining the cited references. In this regard, the Office Action stated only that the combination

would have been obvious "because this allows to keep a high contrast of displayed image regardless of ambient light intensity." (Office Action, p. 2). This alleged motivation is clearly improper in view of well-established Federal Circuit precedent.

It is well-settled law that in order to properly support an obviousness rejection under 35 U.S.C. § 103, there must have been some teaching in the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc., 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

"The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ..." Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure... In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention."

(*Emphasis added.*) In re Dow Chemical Company, 837 F.2d 469, 473 (Fed. Cir. 1988).

In this regard, Applicants note that there must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also requires the prior art to suggest both the combination of elements and the structure resulting from the combination. Stiftung v. Renishaw PLC, 945 Fed.2d 1173 (Fed. Cir. 1991). Therefore, in order to sustain an obviousness rejection based upon a combination of any two or more prior art references, the prior art must properly suggest the desirability of combining the particular elements to derive an OLED, as claimed by the Applicants.

When an obviousness determination is based on multiple prior art references, there must be a showing of some "teaching, suggestion, or reason" to combine the references. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir.

1997) (also noting that the “absence of such a suggestion to combine is dispositive in an obviousness determination”).

Evidence of a suggestion, teaching, or motivation to combine prior art references may flow, inter alia, from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. See In re Dembiczak, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be “clear and particular.” Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617.

If there was no motivation or suggestion to combine selective teachings from multiple prior art references, one of ordinary skill in the art would not have viewed the present invention as obvious. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); Gambro Lundia AB, 110 F.3d at 1579, 42 USPQ2d at 1383 (“The absence of such a suggestion to combine is dispositive in an obviousness determination.”).

Significantly, where there is no apparent disadvantage present in a particular prior art reference, then generally there can be no motivation to combine the teaching of another reference with the particular prior art reference. Winner Int’l Royalty Corp. v. Wang, No 98-1553 (Fed. Cir. January 27, 2000).

In combining Van Order with May, the Office Action said that the combination would be obvious “because this allows to keep a high contrast of displayed image regardless of ambient light intensity.” However, merely identifying some benefit (from hindsight) that results from a combination is not sufficient to justify the combination, and the motivation or suggestion must come from the prior art itself, and the Office Action has failed to identify such a motivation. For

at least the additional reason that the Office Action failed to identify proper motivations or suggestions for combining the various references to properly support the rejections under 35 U.S.C. § 103, those rejections should be withdrawn.

As claims 2-7 are dependent claims that depend from claim 1 either directly or indirectly. Applicant respectfully asserts that these claims also are in condition for allowance

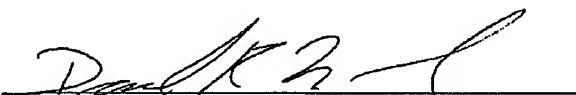
Thus, Applicant respectfully submits that the rejection can be withdrawn and requests that a timely Notice of Allowance be issued in this case.

CONCLUSION

In view of the foregoing, it is believed that all pending claims are in proper condition for allowance. If the Examiner believes that a telephone conference would expedite the examination of the above-identified patent application, the Examiner is invited to call the undersigned.

No fee is believed to be due in connection with this Response to Office Action. If, however, any fee is believed to be due, you are hereby authorized to charge any such fee to deposit account No. 20-0778.

Respectfully submitted,

By: 
Daniel R. McClure
Registration No. 38,962

Thomas, Kayden, Horstemeyer & Risley, LLP
100 Galleria Pkwy, NW
Suite 1750
Atlanta, GA 30339
770-933-9500